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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,286	06/05/2001	Lola M. Reid	114231.120	6715

27160 7590 12/30/2003

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EXAMINER

DIBRINO, MARIANNE NMN

ART UNIT PAPER NUMBER

1644

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,286

Applicant(s)

REID ET AL.

Examiner

DiBrino Marianne

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003 and 27 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendments filed 8/26/03 and 9/27/03 are acknowledged and have been entered.

Claims 35-51 are pending.

2. Applicant is reminded of Applicant's election with traverse of OX-43 as the species of antibody used in the claimed method.

Claims 35-51 are presently being examined.

In view of Applicant's amendments filed 8/26/03 and 9/27/03 the following rejections remain.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 35-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,069,005. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of the '005 patent of isolating hepatic progenitors from adult liver is encompassed by the method of the instant application of enriching for hepatic progenitors from liver.

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5. Claims 35-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,242,252. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of the '252 patent of isolating hepatic progenitors from liver is encompassed by the method of the instant application of enriching for hepatic progenitors from liver.

6. With regard to application of prior art, the instant claims have priority to the filing date of parent application 08/155,939, i.e., 11/19/93, as the claimed invention is not disclosed in parent application 07/741,128.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 50 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is apparent that the monoclonal antibody 374.3 is required to practice the claimed invention. As required elements, they must be known and readily available to the public or obtainable by a repeatable method set forth in the specification. If it is not so obtainable or available, the enablement requirements of 35 USC 112, first paragraph, may be satisfied by a deposit of the pertinent cell line which produces these antibodies. See 37 CFR 1.801-1.809.

If the deposit was made under the provisions of the Budapest Treaty, filing of an affidavit or declaration by applicants, assignees or a statement by an attorney of record over his or her signature and registration number stating that the deposit has been made under the provisions of the Budapest Treaty and that all restrictions upon public access to the deposit will be irrevocably removed upon the grant of a patent on this application is required.

In addition to the conditions under the Budapest Treaty, applicant is required to satisfy that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent in U.S. patent applications.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 C.F.R. 1.801-1.809, an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made at an acceptable depository and that the following criteria have been met:

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(A) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;

(B) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

(C) the deposit will be maintained in a public depository for a period of 30 years after the date of deposit or 5 years after the last request for a sample or for the enforceable life of the patent whichever is longer;

(D) a viability statement in accordance with the provisions of 37 C.F.R. 1.807;

(E) the deposit will be replaced should it become necessary due to inviability, contamination, or loss of capability to function in the manner described in the specification.

Furthermore, unless the deposit was made at or before the time of filing, a declaration filed under 37 C.F.R. 1.132 is necessary to construct a chain of custody. Hybridoma... was deposited after the time of filing. The declaration, executed by a person in a position to know, should identify the deposited hybridoma by its depository accession number, establish that the deposited hybridoma is the same as that described in the specification, and establish that the deposited hybridoma was in applicants' possession at the time of filing. In re Lundak, 27 USPQ 90.

Amendment of the specification to recite the date of deposit and the complete name and address of the depository is required. As an additional means for completing the record, applicant may submit a copy of the contract with the depository for deposit and maintenance of each deposit.

NOTE THE CURRENT ATCC DEPOSITORY ADDRESS

American Type Culture Collection, 10801 University Boulevard, Manassas, VA 20110-2209

Appliant's arguments in Applicant's amendment filed 8/26/03 have been fully considered but are not persuasive.

Biological materials must be known and readily available to the public (See MPEP 2404.01). Neither concept alone is sufficient. The fact that applicant and other members of the public were able to obtain the materials in question from a given company does not establish that upon issuance of a patent on the application that such material would continue to be accessible to the public. The applicant did not make of record any of the facts and circumstances surrounding the access to the biological materials from the company/party, in the case of 374.3 from Hixson and Faris of Brown University, nor is there sufficient evidence as to the company's/party's policy regarding the material if a patent would be granted.

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Further, there is no assurance that a depository/company/party would allow unlimited access to the material if the application has matured into a patent. In the absence of objective evidence that the 374.3 antibody is readily available to the public and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, applicant's arguments are not persuasive and the rejection is maintained.

The Office will accept commercial availability as evidence that a biological material is known and readily available only when the evidence is clear and convincing that the public has access to the material. A product could be commercially available but only at a price that effectively eliminates accessibility to those desiring to obtain a sample. The relationship between the applicant relying on a biological material and the commercial supplier is one factor that would be considered in determining whether the biological material was known and readily available. However, the mere fact that the biological material is commercially available only through the patent holder or the patent holder's agents or assigns shall not, by itself, justify a finding that the necessary material is not readily available, absent reason to believe that access to the biological material would later be improperly restricted. (See MPEP 2404.01).

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 50 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 50 is indefinite in the recitation of 374.3. It's characteristic is not known. The use of "374.3" as the sole means of identifying the claimed antibody renders the claim indefinite because "374.3" is merely a laboratory designation which does not clearly define the claimed product, since different laboratories may use the same laboratory designations to define completely distinct monoclonal antibodies.

11. No claim is allowed.

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12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marianne DiBrino whose telephone number is 703-308-0061 (after 1/7/04 the telephone number is 571-272-0842). The Examiner can normally be reached on Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 (before final) or 703-872-9307 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Marianne DiBrino, Ph.D.

Patent Examiner

Group 1640

Technology Center 1600

December 10, 2003



CHRISTINA CHAN

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600